

ADMINISTRATIVE PANEL DECISION

Exit 10, Inc. v. 淑兰 刘
Case No. D2022-4138

1. The Parties

The Complainant is Exit 10, Inc., United States of America (“United States” or “US”), represented by Shutts & Bowen LLP, United States.

The Respondent is 淑兰 刘, China.

2. The Domain Name and Registrar

The disputed domain name <southordshop.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 2, 2022. On November 3, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on November 4, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 8, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 1, 2022.

The Center appointed Clive Duncan Thorne as the sole panelist in this matter on December 7, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant which is a Florida, United States profit corporation and its affiliated entities have for over 30 years owned and operated a locksmith tool company, specializing in eliminating the rough rivets in the handles commonly used by other manufacturers, and instead utilizing a spot-welding process. The Complainant has invested considerable resources in developing and maintaining its brand, and marketing its products on its website "www.southord.com".

Evidence of its trading activities and products is contained in and exhibited at Annex 3 to the Complaint, which consists of printouts from the Complainant's website "www.southord.com". Throughout the Complaint uses the trade mark SOUTHORD and is referred to as "SouthOrd".

The Complainant is the owner of the US trade mark registration No. 3,515,151 for the mark SOUTHORD in the US classes 13, 19, 21, 23, 28, 31, 34, 35, and 44. The mark was registered on October 14, 2008 which predates registration of the disputed domain name on June 22, 2022. A copy of the certificate of trade mark registration is exhibited as Annex 5 to the Complaint.

The Complainant first used the mark SOUTHORD in connection with its marketing of power and hand operated locksmith tools not later than April 1991.

The Complainant became aware of the Respondent's ownership and use of the disputed domain name since it incorporates the entirety of the mark SOUTHORD. It became aware of the Respondent's website which includes numerous images and text showing the Complainant's locksmith tools bearing the trade mark SOUTHORD. A copy of extracts from the Respondent's website accessed by means of the disputed domain name is exhibited at Annex 4 to the Complaint.

In the absence of a Response and contrary evidence, the Panel finds the evidence adduced by the Complainant and referred to above to be true.

5. Parties' Contentions

A. Complainant

The Complainant submits;

- i. The disputed domain name is identical/confusingly similar to the Complainant's trade mark SOUTHORD;
- ii. There is no evidence that the Respondent has any rights or legitimate interests in the disputed domain name;
- iii. On the evidence adduced by the Complainant the disputed domain name was registered and is being used by the Respondent in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

On the evidence adduced by the Complainant and set out in Section 4 above the Panel is satisfied that the Complainant owns registered trade mark rights in the mark SOUTHORD.

The Complainant submits that the disputed domain name is identical and/or confusingly similar to the Complainant's mark SOUTHORD since it incorporates the entirety of the mark SOUTHORD with no added distinguishing matter other than the term "shop.com". In the Panel's view, the addition of the term "shop" does not prevent a finding of confusing similarity between the disputed domain name and the trade mark SOUTHORD.

The Panel also takes into account on the basis of established authority that the top level domain ".com" should be disregarded for the purpose of establishing confusing similarity.

In the Panel's view the Complainant has established for the purposes of paragraph 4(a)(i) of the Policy that the disputed domain name is confusingly similar to the trade mark SOUTHORD in which the Complainant owns registered rights.

B. Rights or Legitimate Interests

The Complainant submits on the evidence that the Respondent was at no time authorized by it to use the mark SOUTHORD or to register the disputed domain name.

There is no evidence that the Respondent's use of the disputed domain name is in connection with a *bona fide* offering of goods or services or that it is being used for a legitimate fair use without intent for commercial gain. To the contrary, the evidence as contained in Annex 4 shows that the Respondent's registration of the disputed domain name was unauthorized and that the Respondent intended to profit from its use of the Complainant's mark SOUTHORD.

The Complainant submits that "at a minimum" the Respondent would have had constructive notice of the Complainant's US trade mark registration. From the time the Respondent registered the disputed domain name, it has established a website using the mark SOUTHORD which is identical to the Complainant's registered mark and a confusingly similar website to design to that of the Complainant. This can be seen from a comparison of Annexes 3 and 4 to the Complaint.

Given the Complainant's evidence which establishes *prima facie* evidence that the Respondent lacks rights or legitimate interests in the disputed domain name, the burden of production to show that the Respondent has rights or legitimate interests in the disputed domain name passes to the Respondent. Taking into account the lack of a Response and the evidence of the Respondent's confusingly similar website contained in Annex 4 this it has failed to do. Accordingly the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

In support of this element the Complainant submits that the creation by the Respondent of a website using the mark SOUTHORD which is identical to the Complainant's US registered trade mark and in a confusingly similar website design offering highly related and/or competing products to that of the Complainant is evidence of bad faith. It submits that the creation of the confusingly similar website would have been done with the intention that a substantial number of visitors to the Respondent's website would be confused in to believing that it belonged to or had been approved by the Complainant.

The Panel having compared the evidence of the Complainant's and the Respondent's websites as exhibited at Annexes 3 and 4 is satisfied that the Respondent's website is modelled upon that of the Complainant and is confusingly similar to that of the Complainant.

The Complainant submits that there should be a finding of bad faith where the Respondent "knew or should have known" of the Complainant's registered trade mark rights prior to registering the disputed domain name. That is the position in this case where the Respondent registered the disputed domain name over one decade after the Complainant first established rights in the mark SOUTHORD.

The Complainant points out that upon becoming aware of the Respondent's conduct in creating a confusingly similar website and registering the disputed domain name, it attempted to send by courier a cease and desist letter to the Respondent, a copy of which is exhibited at Annex 9 to the Complaint. The letter was returned because the contact address listed on the Respondent's website was a "faulty" address. The Complainant submits this is further evidence of the use of the disputed domain name in bad faith.

Having considered the Complainant's submissions and supporting evidence the Panel is satisfied that the Respondent by registering and using the disputed domain name "has intentionally attempted to attract for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website"; within paragraph 4(b)(iv) of the Policy.

Accordingly the Panel finds that the disputed domain name has been registered and is being used in bad faith by the Respondent within paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <southordshop.com> be transferred to the Complainant.

/Clive Duncan Thorne/

Clive Duncan Thorne

Sole Panelist

Date: December 20, 2022